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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/532,686	03/22/2000	Jonathan D. Trumbull	6678.US.01	8859

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EXAMINER

MORAN, MARJORIE A

ART UNIT	PAPER NUMBER
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1631

DATE MAILED: 05/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/532,686

Applicant(s)

TRUMBULL ET AL.

Examiner

Marjorie A. Moran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 January 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-4, 7-10, 12-14, 16-27, 29, 30 and 33-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-4, 7-10, 12-14, 16-27, 29, 30 and 33-36 is/are rejected.
- 7) ☒ Claim(s) 8 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Applicant is advised that the examiner of this application has changed. Claims 2-4, 7-10, 12-14, 16-27, 29-30, and 33-36 are pending. All rejections and objections not reiterated below are hereby withdrawn.

Information Disclosure Statement

It is noted that applicant admits in the response filed 1/24/05 that publication dates for two non-considered brochures can not be established. While the examiner appreciates applicant's efforts, these references do not comply with 37 CFR 1.98, and are still not considered.

Claim Objections

Claim 8 is objected to because of the following informalities: the members of the Markush group should be connected by --and-- before the last element of the group. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 2-4, 7-10, 12-14, 16-27, 29-30, and 33-36 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in

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such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. This is a NEW MATTER rejection.

Claim 2 recites a flowcell with a channel or chamber containing "at least one" test subject. A channel or chamber containing more than one test subject in a flow cell is new matter. In the response filed 1/24/05, applicant points to pages 9 and 12 of the specification, and to various figures, for support for the amendment to claim 2. The originally filed specification, on pages 9 and 12-13, provide support for a flow cell with a channel or chamber containing a (singular) test subject. The Figures only disclose a test sample (T) in a flow cell, but do not disclose multiple (T's) in a single flow cell. The examples of "test subject" provided on pages 9 and 13 are "a biological cell, such as an oocyte, an ion channel..." and "a cell, such as, for example, a *Xenopus* oocyte..." All examples are clearly directed to a SINGLE test subject; i.e. the specification does NOT disclose cells, or ion channels in a membrane as being held within a flow cell in the originally filed specification or claims. As experiments for measuring conductance/electrophysiological reactions similar to the claimed method (e.g. patch-clamp experiments) are routinely conducted on a SINGLE test subject such as an individual cell or a single piece of membrane per chamber, the disclosure for a singular test subject per flow cell is not a general disclosure for either singular or multiple test subjects per flow cell. As none of the originally filed specification, claims or drawings provide support for multiple test subjects in a channel or chamber of a flow cell, claim 2

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recites new matter. Claims 2-4, 7-10 and 35-36 depend from claim 2 and therefore also recite new matter.

Claim 12 recites a movable applicator for dispensing a test material "directly into a recording station" which is new matter. The amendment introducing this limitation was filed 6/28/04.

Original claim 11 recited a "means for dispensing" material into "recording stations", but did not recite any limitation with regard to "direct" application or dispensation of the material into a recording station. Pages 9, 11-12 and 14 of the originally filed specification provide support for an applicator which dispenses fluids into a flow-cell, or specifically into a channel of a flow-cell. While the flow-cell is part of the recording station, the recording station itself is a larger entity comprising other means, including electrodes, etc. The specification makes it clear, on page 14, lines 15-30 that fluid from the applicator should be dispensed *directly into the flow cell*, because fluid spread to other parts of the recording station is undesirable. This disclosure indicates that an applicator which dispenses directly into the recording station (i.e. outside the flow-cell) is to be avoided and is NOT part of their originally conceived invention. As the originally filed disclosure fails to provide support for the new limitation, claim 12 recites new matter. Claims 13-14, 16-27, 29-30, and 33-34 depend from claim 12 and therefore also recite new matter.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 12-14, 16-27, 29-30, and 34-36 are rejected under 35 U.S.C. 102(e) as being anticipated by PETERSEN et al. (US 6,682,649, filed 10/6/1999).

PETERSEN teaches an apparatus with a multiplicity of sites for measuring electrophysiological responses of a test subject wherein each site is connected to electrodes (col. 6, line 48-col. 7, line 52). PETERSEN teaches that his apparatus may comprise a dispensing or pipetting system such as an nQUAD aspirate dispenser (col. 11, lines 28-37), and comprises a computer for controlling the apparatus (col. 7, lines 17-27), thus anticipating claims 12-14, 16 and 20-23. PETERSEN teaches that is apparatus comprises a chamber for holding each test subject, a set of electrodes, and elements for manipulating the electrodes (col. 13, lines 57-68 and claim 1), thus anticipating claims 24 and 26.

Conclusion

No claims are allowed.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marjorie A. Moran whose telephone number is (571) 272-0720. The examiner can normally be reached on Mon,Wed: 7-1:30; Tue,Thur: 7:30-6; Fri 7-3:30 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ardin Marschel can be reached on (571)272-0718. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Marjorie A. Moran
Primary Examiner
Art Unit 1631

Marjorie A. Moran
5/16/05